

Application No.: 10/038,640
Amendment and Response dated February 26, 2008
Reply to Office Action of October 30, 2007
Docket No.: 792-62 RCE II
Page 7

Remarks/Arguments:

Introduction

Claims 6, 76-81, 84-89 and 93 are pending. Claims 1-5, 7-75, 82-83 and 90-92 are canceled. Claims 6, 76 and 84 have been amended to describe that the nominal diameters of the first and second tubular wall segments are substantially the same. Support for these amendments may be found in previously presented claims 82 and 92, which are now canceled. No new matter is introduced with these amendments. Entry of the claim amendments are respectfully requested

Section 103 Rejections

Claims 6, 76-81, 84-89 and 93 are rejected under 35 U.S.C. §103(a) as allegedly being obvious over U.S. Patent No. 6,860,900 to Clerc et al. (hereinafter "Clerc") in view of U.S. Patent No. 5,575,818 to Pinchuk (hereinafter "Pinchuk"). Applicant respectfully traverses.

Clerc describes a stent 310 (see FIG. 6) having a fixation section 310 and a main body section 334, 336. The stent 310 is a braided stent formed by braiding filaments 336 at a braid angle θ . The braid angle θ in the two sections is obtuse. The obtuse braid angle θ for the fixation section 310 is greater than the obtuse braid angle θ for the main body section 334, 336. The purpose of the fixation section 310 is to anchor this section, and thereby the stent 310, to a bodily lumen.

Clerc, however fails to teach or suggest a prosthesis comprising, *inter alia*, a plurality of discrete first tubular segments and a plurality of discrete second tubular segments in an alternating sequence, as set forth in independent claims 6, 76 and 84. In other words, Clerc only teaches or suggests a braided stent having a stent body with one braid angle and one fixation end with a different braid angle.

The examiner then modifies to the combined teachings of Clerc and Pinchuk to arrive at the claimed plurality of first and second tubular segments by stating that “mere duplication of essential working parts of a device involves only routine skill in the art, as set forth by *In re Harza*, 124 USPQ 378, 380 (CCPA 1960). The Court in *In re Harza* held that a recitation of a plurality of ribs on each side of a web was unpatentable over a reference that showed only a single rib on each side of a web. *In re Harza* at 380. The Court, however, also held that duplication of essential works parts may patentably distinct when combined with another element. *In re Harza* at 381. For example the Court in *In re Harza* held that a recitation of “each rib being substantially as high as the spacing between adjacent ribs” was patentably distinct over the applied art because it produced new and unobvious results not suggested by any combination of references. *In re Harza* at 381.

In the present case, independent claims 6, 76 and 84 are directed to a prosthesis comprising, *inter alia*, a plurality of discrete first tubular segments and a plurality of discrete second tubular segments in an alternating sequence, wherein the nominal diameters of the first and second tubular wall segments are substantially the same. Clerc and Pinchuk fail to teach or suggest such a combination. For example, the only pluralities of locking rings described in Pinchuk are locking rings that have substantially larger diameters than the main body of its stent. (See, e.g., FIG. 6). Moreover, the stated purpose of the locking rings of Pinchuk is to secure the stent to a bodily lumen via the enlarged locking rings. In contrast, the alternating plurality of discrete first tubular segments and a plurality of discrete second tubular segments of the present invention provide a prosthesis that more readily conforms to a curvature of a body lumen in which the prosthesis is deployed, as set forth and recited in independent claims 6, 76 and 84. Such a new and unobvious result resulting from the combination of claimed elements is patentably distinct over the applied art. *In re Harza* at 381.

Further, as described in the previous submission, Pinchuk fails to teach or suggest that its alleged teaching of a plurality of locking rings may be used with a braided stent having an

obtuse braid angle along its main body. As Pinchuk teaches that its main stent body must be braided at an acute angle, Pinchuk teaches away from the stent of Clerc which requires an obtuse braid angle. Still furthermore, although Pinchuk describes that "stents with locking rings along the body of the stent can be used" at column 10, lines 21-22, Pinchuk fails to teach or suggest that such an arrangement may be a discrete alternating sequence, as set forth in the present independent claims.

In establishing a *prima facie* case of obviousness, the cited references must be considered for the entirety of their teachings. *Bausch & Lomb, Inc. v. Barnes-Hind, Inc.*, 230 U.S.P.Q. 416, 419 (Fed. Cir. 1986). It is impermissible during examination to pick and choose from a reference only so much that supports the alleged rejection. *Id.* It is only through hindsight reconstruction does the examiner attempt to reach the present invention through the combined teachings of Clerc and Pinchuk. It is also well established, however, that hindsight reconstruction of a reference does not present a *prima facie* case of obviousness, and any attempt at hindsight reconstruction using Applicants' disclosure is strictly prohibited. *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1445-46 (Fed. Cir. 1993). As Clerc and Pinchuk, individually or in combination, fail to teach or suggest the recited prosthesis comprising, *inter alia*, a plurality of discrete first tubular segments and a plurality of discrete second tubular segments in an alternating sequence, as set forth in independent claims 6, 76 and 84, any attempt to modify the teachings of Clerc and/or Pinchuk to the same is clearly hindsight reconstruction.

Therefore, reconsideration and withdrawal of the rejection of claims 6, 76-81, 84-89 and 93 under 35 U.S.C. §103(a) are respectfully requested.

Application No.: 10/038,640
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Docket No.: 792-62 RCE II
Page 10


Summary

Therefore, Applicants respectfully submit that independent claims 6, 76 and 84, and all claims dependent therefrom, are patentably distinct. This application is believed to be in condition for allowance. Favorable action thereon is therefore respectfully solicited.

Should the Examiner have any questions or comments concerning the above, the Examiner is respectfully invited to contact the undersigned attorney at the telephone number given below.

The Commissioner is hereby authorized to charge payment of any additional fees associated with this communication, or credit any overpayment, to Deposit Account No. 08-2461. Such authorization includes authorization to charge fees for extensions of time, if any, under 37 C.F.R. § 1.17 and also should be treated as a constructive petition for an extension of time in this reply or any future reply pursuant to 37 C.F.R. § 1.136.

Respectfully submitted,



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